REPLY/AMENDMENT FEE TRANSMITTAL

Attorney Docket No.	95-456
Application Number	09/756,697
Filing Date	January 10, 2001
First Named Inventor	GRESS
Group Art Unit	2157

AMOUNT ENCLOSED	$ 0	Examiner Name	OSMAN, Ramy M

FEE CALCULATION (fees effective 10/01/2003)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra		Rate	Calculations
TOTAL CLAIMS	70	78	0 [3]	X	$58.00 =	$0
INDEPENDENT CLAIMS	8	8	0	X	$200.00 =	$0

Since an Official Action set an <u>original</u> due date of_____, petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month ($120); 2 months ($450); 3 months ($1020); 4 months ($1,590); 5 months ($2,160)):	$0
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee ($110)	+
Total of above Calculations =	$0
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)	-
TOTAL FEES DUE =	$0

(1) If entry (1) is less than entry (2), entry (3) is "0".
(2) If entry (2) is less than 20, change entry (2) to "20".
(4) If entry (4) is less than entry (5), entry (6) is "0".
(5) If entry (5) is less than 3, change entry (5) to "3".

METHOD OF PAYMENT

[ ] Check enclosed as payment.

[ ] Charge "TOTAL FEES DUE" to the Deposit Account No., below.

AUTHORIZATION

[X] If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees under 37 CFR 1.16 or 1.17 necessary to maintain pendency of the present application to:

Deposit Account No.:	50-1130
OrderNo.: (Client/Matter)	95-456

SUBMITTED BY: LEON R. TURKEVICH, ESQ.

Typed Name	Leon R. Turkevich	Reg. No.	34,035
Signature		Date	May 9, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :

GRESS et al.   :

Serial No.: 09/756,697   :   Group Art Unit: 2157

                                  :

Filed: January 10, 2001   :   Examiner: OSMAN, Ramy M

For: UNIFIED MESSAGING SYSTEM CONFIGURED FOR TRANSPORT OF
        ENCRYPTED MESSAGES

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed April 10, 2007, Applicant traverses the restriction requirement of pending claims 1, 3-13, 15-22, 24-30, 32-37, 39-49, 51-58, 60-70, and 72-78 for the reasons set forth below, and requests reconsideration that the Restriction Requirement be withdrawn.

Applicant traverses the restriction requirement on procedural grounds as being untimely and unnecessary under MPEP §§ 811; 818.03; and 818.03(a-c). Applicant reserves the right to file a petition for withdrawl of the restriction requirement under 37 CFR §1.144. Applicant does not traverse whether the inventions are independent and distinct.

Specifically, the Examiner has failed to comply with either of the two requirements of MPEP §811, which states:

[T]he examiner should make a proper requirement <u>as early as possible</u> in the prosecution, in the first action if possible, otherwise, <u>as soon as the need for a proper requirement develops</u>. ... Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a <u>serious burden</u> if restriction is not required.

(Emphasis added).

The Examiner asserts in the Restriction Requirement that the claims should be restricted into two groups:

Group I: Claims 1, 3-7, 10, 22, 24-26, 29, 37, 39-43, 46,58, 60-64, and 67 are "drawn to *encrypting a message* for secure transmission, classified in class 709, subclass 206."

Group II: Claims 8, 9, 11-13, 15-21, 27, 28, 30, 32-36, 44, 45, 47-49, 51-57, 65, 66, 68-70, and 72-78 are "drawn to *retrieving a decrypted* [sic] *stored message*, classified in class 709, subclass 219."

The Examiner, however, has failed to comply with <u>either</u> of the requirements of making the restriction requirement (1) in the first action or as soon as the "need" for a proper requirement develops, *and* (2) demonstrating a "serious burden" if the restriction is not required.

The Examiner has failed to comply with the first requirement because claims 1-78 were <u>originally filed</u> with the application: independent claims 1, 22[1], 37, and 58 as originally filed *each* specified causing encryption of the message into an *encrypted message* based on the encryption key supplied by the user, as illustrated in the representative claim 1 as originally filed:

1. A method *in a unified communications system*, the method comprising:
receiving a request for a user interface session to enable a user to leave a message for an identified destination subscriber;
generating a first prompt enabling the user to select encryption of the message;
generating a second prompt, based on the user selecting encryption of the message, for the user to supply an encryption key;

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[1]Claim 22 specifically recited "causing the message to be encrypted into an encrypted file based on the encryption key supplied by the user".

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causing encryption of the message into an encrypted message based on the encryption key supplied by the user; and

outputting the encrypted message to a determined destination based on determined subscriber profile attributes for the identified destination subscriber.

Hence, the subject matter of Group I ("encrypting a message for secure transmission") was specified in the claims as originally filed.

Further, independent claims 11, 30[2], 47, and 68 as originally filed *each* specified *attempting decrypting* of the one stored message based on the decryption key supplied by the messaging subscriber, as illustrated in the representative claim 11 as originally filed:

11. A method *in a unified communications system*, the method comprising:

receiving a request for a user interface session to enable a messaging subscriber to retrieve stored messages;

accessing subscriber profile information from a subscriber profile directory according to a prescribed open network protocol;

determining one of the stored messages is encrypted based on access of a message store according to a prescribed open network protocol and based on the accessed subscriber profile information;

generating a prompt, based on identifying the one stored message as encrypted, for the messaging subscriber to supply a decryption key; and

attempting decrypting of the one stored message based on the decryption key supplied by the messaging subscriber.

Hence, the subject matter of Group II ("retrieving an [encrypted] stored message") was specified in the claims as originally filed. (It should be noted that if the Examiner maintains that Group II is directed to retrieving a "decrypted" stored message, as opposed to retrieving an "encrypted" stored message as specified in the claims, Applicant further traverses the Restriction Requirement as mischaracterizing the invention.)

Despite the foregoing, the Examiner has neglected to make a Restriction Requirement over the course of over **three years** of prosecution: the Office Actions mailed April 22, 2004 and October 25, 2004 did not impose any restriction requirements; to the contrary, those Office

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[2]Claim 30 specifically recites "causing attempted decryption of the one stored message into a decryption result based on the decryption key supplied by the user".

Actions relied on the <u>same applied references</u> (e.g., Olkin plus Picard on April 22, 2004, Olkin plus Lee on October 25, 2004) in raising rejections under 35 USC §103 of <u>both</u> groups of claims. The Examiner finally rejected claims 1-5, 7-16, 18-24, 26-33, 35-41, 43-52, 54-62, 64-73, and 75-78 on May 18, 2005 as unpatentable under §103 in view of Lee and Olkin.

Subsequent to the Applicant filing a Request for Continued Examination (RCE) on July 15, 2005, the Examiner issued non-final Office Actions on October 3, 2005[3], April 18, 2006[4], and October 11, 2006[5], where <u>each Office Action grouped all independent claims within the</u> <u>**same rejection**</u>.

Hence, the Restriction Requirement is improper because it is untimely by almost <u>three</u> <u>years</u>. Further, the Restriction Requirement fails to identify why it could not have been made earlier, for example during <u>initial examination over three years ago</u>, when the claims were first searched on April 7, 2004 (see below).

The Examiner also has failed to comply with the second requirement and has not even attempted to demonstrate any "serious burden" if the restriction is not required. To the contrary, the Examiner simply identifies Group I as classified under Class 709, subclass 206, and Group II as classified under Class 709, subclass 219.

In fact, the Examiner has already searched **numerous** classes and subclasses **including** **Class/Subclass 709/206**, as demonstrated by the attached Search Records for the subject

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[3]Claims 1, 3-5, 7-12, 15, 16, 18-22, 24, 26-30, 33, 35-37, 39-41, 43-48, 51, 52, 54-58, 60-62, 64-69, 72, 73, and 75-78 were rejected under 35 USC §103 in view of Gifford et al., and Yotsukura.

[4]Claims 1, 3-5, 7-12, 15, 16, 18-22, 24, 26-30, 33, 35-37, 39-41, 43-48, 51, 52, 54-58, 60-62, 64-69, 72, 73, and 75-78 were rejected under 35 USC §103 in view of Anderson, Sasaki et al., and Gifford et al.

[5]Claims 1, 3-5, 7-12, 15, 16, 18-22, 24, 26-30, 33, 35-37, 39-41, 43-48, 51, 52, 54-58, 60-62, 64-69, 72, 73, and 75-78 were rejected under 35 USC §103 in view of Anderson, Shiigi, Sasaki et al., and Gifford et al.

application from the Private Pair Website. In summary, the Examiner has <u>already searched</u> the following classes and subclasses:

Search Date	Class/Subclass Searched	Paper Identifier
April 7, 2004	**709/206**, 202, 246	(Right Outside File Wrapper)
April 8, 2004	713/219, 249, 152	(Right Outside File Wrapper)
September 29, 2004	**709/** 202, **206** 713/151, 152 379/67.1, 88.09, 88.13 379/902	Part of Paper No. 2
May 6, 2005	**709/**203, **206** 380/277, 279	Part of Paper No. 3
August 31, 2005	**709/**203, **206** 379/277, 279	Part of Paper No. 5
March 13, 2006	709/223-229	Part of Paper No. 6

Hence, Class/Subclass 709/206 has already been searched by the Examiner on <u>4 separate occasions.</u>

Further, the attached Class Definitions from the USPTO Website demonstrate that Class/Subclass 709/206 is <u>not</u> necessarily directed to encrypting a message for secure transmission, as asserted, nor is Class/Subclass 709/219 necessarily directed to retrieving an "encrypted" message, as claimed. Rather 709/219 is defined generally as transferring "large blocks of data (e.g., streamed data) ... between a remote file server and a requesting computer."

Finally, the lack of any "serious burden" is evident by a voice mail message left with the undersigned on March 28, 2007 at 1:01 PM, where Examiner Osman indicated that "the application is **ready for allowance**, except two issues: (1) formal drawings are required, and *(2) a species restriction on the claims will be necessary based on Figs. 5A and 5B.* If we can do this over the phone, you elect one of the groups and submit formal drawings via fax, I can do an

Examiner's Amendment ...." Consequently, there is <u>no burden</u> in withdrawing the Restriction Requirement, since the Examiner is **ready to allow the application**.

Hence, the Restriction Requirement fails to demonstrate <u>any</u> burden if the Restriction Requirement is not imposed, *especially* given that 709/206 has *already* been searched, the attached class definition demonstrates that 709/219 is <u>not relevant</u> to the subject matter claimed in Group II, and the Examiner indicated via a voice message to the undersigned that he is **<u>ready to allow the application once the Applicant chooses which group should be allowed to issue</u>**.

For these and other reasons, the Restriction Requirement should be withdrawn, *especially* since Applicant would be severely prejudiced by this late issuance of the pending Restriction Requirement after **<u>three years of ongoing prosecution</u>**. Indeed, any potential divisional applications will have lost over <u>three years</u> due to the Examiner's delay in issuance of the restriction, *especially* in view of the assertion that a properly filed divisional *still* may be subject to a double patenting rejection, for example if the Examiner does not permit rejoinder of *all* the non-elected claims (i.e., both non-elected independent claims *and* non-elected *dependent claims depending from elected independent claims*) upon allowance of the elected claims.

Applicant provisionally elects Group I, with traverse as to procedure but without traverse as to independence or distinctness of the groups. This provisional election, however, does <u>not</u> authorize the Examiner to cancel the claims of Group II: if the Examiner maintains that the restriction is proper, Applicant requests the Examiner issue a Final Restriction Requirement to permit Applicant to file a Petition for Withdrawl of the Restriction Requirement under 37 CFR §1.144.

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To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a) or 1.17(e), to Deposit Account No. 50-1130, under Order No. 95-456, and please credit any excess fees to such deposit account.

Respectfully submitted,

Leon R. Turkevich
Registration No. 34,035

Customer No. 23164
Date: May 9, 2007

Attached: 9 Pages of Exhibits